

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings include new figures 4 and 5. These new figures are presented to more clearly illustrate the detent sub-assembly being housed within the upper portion of the bushing and that a groove in the bushing engages the extrusion on the detent sub-assembly for preventing rotation of the sub-assembly in relation to the bushing. These new figures do not present new matters.

Attachment: New Sheet

REMARKS/ARGUMENTS

Specification

In the specification, the second paragraphs on page 4 has been amended to add numeral 118 to the notch of the bushing. This feature was previously described and claimed. No new matter has been added.

Drawings

New figures 4 and 5 are added in response to the Office Action. The figures more clearly illustrate the detent sub-assembly being housed within the upper portion of the bushing and that a groove (118) in the bushing engages the extrusion on the detent sub-assembly for preventing rotation of the sub-assembly in relation to the bushing. These new figures do not present new matters.

35 USC 102(b)

Claims 12-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Robinson (U.S. Patent No. 3,986,410). The applicant respectfully disagrees for the reasons discussed below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (MPEP § 2131). As can be gleaned from the cited case law, the requirement is that each element must be either expressly or inherently described. In examining the portion of the cited reference that the examiner has referred the applicant to (Figs. 1-5), there is no description of a detent sub-assembly housed in planar relation to the panel. Claim 12 requires that the detent sub-assembly be positioned in a plane with the panel (page 5, last paragraph). Robinson fails to disclose this limitation.

As for claim 14, claim 14 has been amended to require, among other things, a detent sub-assembly positioned in an upper portion of a bushing. Robinson does not disclose this.

Based on the failure of Robinson to disclose all of the elements of the claims 12 and 14, the applicant submits that claims 12-14 are in condition for allowance.

35 USC 103(a)

Claims 1-6, 8, 9 were rejected under 35 U.S.C. § 103(a) as being obvious by Robinson (U.S. Patent No. 3,986,410) in view of Nation (U.S. Patent No. 4,891,476). The applicant respectfully disagrees for the reasons discussed below.

Lack of Motivation to Combine

After it has been determined that certain prior art can be combined because it is analogous art, the Office must still show that the prior art contains a suggestion, i.e., a motivation, for the proposed combination. M.P.E.P. 2143.01. In other words, the prior art as a whole must contain something to suggest the "desirability," thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). Here, there is absolutely no teaching or suggestion to combine the Robinson device with the Nation device. Robinson discloses a rotary switch, and Nation discloses a push-button switch. Although the Nation device is called an "index rotary switch," the detent mechanism is substantially different from detent mechanisms used in typical rotary switches as disclosed in Robinson.

In Robinson, a hill and valley type detent is provided as part of an indexing mechanism to restrict the rotational positions of a shaft. A long-wearing detent spring plate 20 is provided to bias against the hills 35. This index mechanism is positioned in the bottom portion of the bushing.

In Nation, a push-button switch utilizes a typical index actuator as seen in pens with actuator buttons on top (col. 3, line 54-56), which is fundamentally different from the index mechanism of Robinson. As shown in figure 1 of the Nation patent, this type of index mechanism requires a push button, and various engagement parts (22, 24) cooperating together to convert a linear motion (pushing the button downward) to a rotary motion (the turning of part 28) (col. 3, lines 52-54). The mechanical arrangement of these parts in a typical push-button index mechanism generally requires the pushbutton to slidably receive other parts (24 and 28) as shown in Fig. 1. And because of this arrangement, a pushbutton typically has detents to interact with the inner surface of a bushing as shown in Fig. 4 of the Nation patent.

The Nation patent offers no motivation to combine the two references. Having a push-button type arrangement as taught by Nation does not benefit the Robinson switch in anyway. Combining the two references would not make the Robinson device more desirable for its intended purpose.

Motivation to Combine based on Impermissible Hindsight

Any motivation to combine the Robinson patent and the Nation patent would constitute impermissible hindsight. The Office is using the same suggestion/motivation (reducing the depth of switch) that is disclosed in the current patent application.

"Any judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

The Robinson Switch would have been Destroyed in Such Combination

In addition, due to the fundamental differences in the two index mechanism types, combination of the two references would destroy the Robinson device. Robinson is directed to a rotary switch where a user directly rotates a knob to make desired electrical contacts at various positions. The combination as suggested by the Office would result in a pushbutton on/off switch.

Teaching Away

Furthermore, the Federal Circuit has indicated that one important indicium of nonobviousness is "teaching away from" the claimed invention by the prior art, and has reversed rejections of claims where it found that prior art references applied by the PTO in fact teaching away from what was being claimed. Therefore, an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. In re Geisler, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting In re Malagari, 499 F.2d at 1303, 182 USPQ at 553).

The Robinson patent teaches away from having the detent sub-assembly in the upper portion of the bushing. Robinson requires the use of a spring plate 20 to cooperate with hill and valley structure that is secured onto the bottom portion of the bushing (see Fig. 4 of Robinson).

Office has the Burden of Proof

The applicant doesn't have the initial burden of proving non-obviousness. The Office has the initial burden of setting forth a prima facie case of obviousness, and to do that the Office must identify specific teachings, suggestions or motivations in the prior art for making the claimed combination. Merely pointing out that various elements by themselves are known in the prior art is insufficient. Nor is it sufficient to merely state that combination of the missing elements is obvious because their combination would be beneficial. If that were the standard nothing would ever be patentable.

Non-Analogous Art

Further, the Nation patent is an non-analogous art due to its fundamental difference in solving different types of electrical switch needs. Simply put, the Nation patent involves different problems and different solutions. It is directed towards a pushbutton on/off switch to converts linear motion to rotary motion.

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general

scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). MPEP 2141.01(a).

Objective Evidence of Nonobviousness

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The applicants has, through the efforts of research and development, invented a "very low profile" rotary switch. This "very low profile" switch has brought many positive and surprised feedbacks from end users and experts in the technology for its reduced profile and weight. This "very low profile" rotary switch has achieved commercial success, and satisfies a long-felt need in the industry.

Rejections to Claims 7, 10-11

Claim 7 was rejected under 35 U.S.C. § 103(a) as being obvious by Robinson (U.S. Patent No. 3,986,410) in view of Nation (U.S. Patent No. 4,891,476), and further in view of Rao et al. (U.S. Pat. No. 6,541,723). The applicant respectfully disagrees.

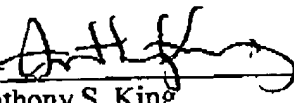
Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being obvious by Robinson (U.S. Patent No. 3,986,410) in view of Nation (U.S. Patent No. 4,891,476), and further in view of Garcia (U.S. Patent No. 5,606,155) and Lockard (U.S. Patent No. 3,736,390). The applicant respectfully disagrees.

Rejections to these claims which are dependent on claim 1 are moot in view of the arguments above.

Request For Allowance

Claims 1-14 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,
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